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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/553,068	04/20/2000	Christopher Phillips	04814.P017	5825
25943	7590	03/06/2006	EXAMINER	
SCHWABE, WILLIAMSON & WYATT, P.C. PACWEST CENTER, SUITE 1900 1211 SW FIFTH AVENUE PORTLAND, OR 97204			PATEL, JAGDISH	
			ART UNIT	PAPER NUMBER
			3624	

DATE MAILED: 03/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/553,068

Applicant(s)

PHILLIPS ET AL.

Examiner

JAGDISH PATEL

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4,7-10,13-15,17-20,22-32, 35-45,48 and 50 is/are pending in the application.
- 4a) Of the above claim(s) 26-32 and 35-42 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4,7-10,13-15,17-20,22-25,43-45,48 and 50 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This communication is in response to amendment filed 12/14/2005.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/14/05 has been entered.

Response to Amendment

3. Claims 1, 23 and 43 have been amended. Claims 1-4, 7-10, 13-15, 17-20, 22-25, 43-45, 48 and 50 are currently under examination.

Response to Arguments

4. Applicant's arguments with respect to the rejected claims have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 112

5. Claims 1-4, 7-10, 13-15, 17-20, 22-25, 43-45, 48 and 50 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites elements of an apparatus (or a system) and method (or process).

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-4, 7-10, 13-15, 17-20, 22-25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-4, 7-10, 13-15, 17-20, 22-25 are not sufficiently precise due to the combining of two different statutory classes of invention in a single claim. The preamble the claim refers to a method, but the body of the claim discusses the specifics of the system. For example, claim 1 recites “billing service..operated independent of one or more billing data issuing sources..”, and subsequently the claim then deals with the specifics of a method step, such as “obtaining a first and second billing data” “providing first billing data for use by a user” etc.

Claims 2-4, 7-10, 13-15, 17-20, 22-25 are rejected as being dependent on claim 1 as discussed above.

8. Claims 1-4, 7-10, 13-15, 17-20, 22-25 are also rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap

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between the steps. See MPEP § 2172.01. The omitted steps are: manner in which the issuing source receives the usage of the first (second) billing data with respect to the first (second) website. The claim also fails to recites that actual usage of the billing data provided to the user are consumed by the user since the limitation “to conduct transactions with a first web site” is recited as intended use of the billing data. The further recites limitation “the billing service .. facilitating said use with said first web site, receiving notification of usage of the first billing data from its issuing source”. However, the claim the billing service is not recited as any connection to the “use with said first web site”. For example, there is no communication of the data pertaining to the usage of the billing data to the billing service and/or the billing data issuing source(s).

Claim Rejections - 35 USC § 101

9. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

10. Claims 1-4, 7-10, 13-15, 17-20, 22-25 are rejected under 35 U.S.C. §101 because the claimed invention is directed to a non statutory subject matter.

35 U.S.C. §101 requires that in order to be patentable the invention must be a “new and useful process, machine, manufacture or composition of matter or new and useful improvement thereof” (emphasis added). Applicant’s claims mentioned above are intended to embrace or overlap two different statutory classes of invention as set forth in 35 U.S.C. §101. The claim begins by discussing a method (ex. Preamble of claim 1), the body of the claim discusses the specifics of the system and method (refer to claim 1). (see rejection of claims under 35 U.S.C. §112, second paragraph, for specific details regarding this issue). “a claim of this type is precluded by express language of 35 U.S.C. §101 which is drafted so as to set forth statutory the statutory classes of invention in the alternative only”, Ex parte Lyell (17USPQ2d 1548).

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 1-4, 7-10, 13, 14, 20, 25, 43-45, 48, 49, 51 and 52 rejected under 35 U.S.C. 103(a) as being unpatentable over Flitcroft and further in view of PR Newswire article CITIBANK AND FIRST CITY BANCORPORATION OF TEXAS IN MERCHANT CREDIT CARD PROCESSING AGREEMENT, July 19, 1990. (hereafter Citibank).

Per claim 1: Flitcroft teaches a computer implemented method comprising:

the billing service providing a first billing data for use by a user to conduct transactions with a first web site, and facilitating said exclusive use with said first web site, including receiving notification of usage of the first billing data from its issuing source;

and

the billing service providing a second billing data for use by a user to conduct transactions with a second web site, and facilitating said exclusive use with said second web site, including receiving notification of usage of the first billing data from its issuing source;

(see col. 10 L 25-55 capability of transmitting the limited-use credit card numbers to customers, see col. 16 L 16 L 46-59 .. alternatively, a credit card number can be used, for example, to implement an installment plan where the credit card number is, for example, only valid for twelve payments for a pre-arranged transaction limit for twelve months to a single merchant. This plan provides security against fraud because it is locked to a single merchant, and it is only good for one year. Or similarly, a credit card number can be used to implement a debit plan where the credit card number is limited to a specific merchant. When the limited-use number is limited to a specific merchant, the merchant can be prearranged by the user or can be determined by first use. See col. 19 L 22-34)

(refer to Fig. 8 and col. 7 L 9-20 , first and second billing data correspond to temporary credit transaction numbers obtained by a billing service)

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Flitcroft fails to teach, however, Citibank, in the same field of endeavor teaches that (a) the billing service (CAS) provides the first and the second billing data (i.e. credit card numbers and billing data) for use by a user with a first web site. (Noting that same user may be issued a plurality of credit cards which can be used at any merchant web sites). Furthermore, It is obvious that the card issuing source (banks such as Citibank) provides notification of usage of the credit cards to the user. Note that same credit card issuing source can issue a plurality of credit cards to the user.

It would have been obvious to modify Flitcroft in view of Citibank to incorporate the features discussed as above, because this would conform to the existing business practices billing data processing methods.

Claim 2. the billing service providing the first billing data to the user comprises providing said first billing data in advance of the user registering with said first web site.

(col. 10 L 25+ limited-use credit card numbers .. delivered to the to the customer via the mail)

Claim 3. Flitcroft fails to teach, however, Demoff in the same field of endeavor teaches providing said first billing data to the user in real time while the user registering with said first web site (Fig. 8 and para [0042]).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate this process in Flitcroft because it would make issuing the billing data faster and more reliable. Providing the billing data the time the user is conducting a transaction also makes him or her more likely to use the billing data to complete the transaction.

Claim 4. wherein the first billing data comprises a first credit card identifier, and the second billing data comprises a second credit card identifier, separate and distinct from said first credit card identifier (see claim 1 analysis, Flitcroft explicitly teaches that the billing data is

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credit card numbers and see “randomness in credit card numbers” as discussed at col. 12, L10 which indicate distinctness of the credit card numbers)).

Claims 7: said first web site requiring first payment format;

paying for a transaction with said first web site according to said first payment format;

[see col. 15 L 25-30 “correct format for a credit card number with a valid check sum”];

billing the user according to billing arrangement different from a billing arrangement corresponding to said billing format.

[see col. 15 L 25-30, see master credit card number]

Claims 8 and 9 are similarly analyzed as claim 7.

Claim 10. The method of claim 1 wherein;
the billing service obtaining comprises the billing service obtaining said first billing data from a financial institution that is a billing data source (col. 12 L 38 –41 “issuing bank”).

Claim 13. Flitcroft fails to teach, however, Demoff in the same field of endeavor teaches the billing service obtaining comprises the billing service obtaining in real time at least one of said first and second billing data in real-time just prior to providing the selected ..billing data to the user

(refer to Fig. 8 and col. 7 as discussed before)

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate this process in Flitcroft because it would make issuing the billing data faster and more reliable. Providing the billing data in real-time just prior to the providing the data to the user is conducting a transaction improves security of the transaction because this minimizes chances of theft or unauthorized use.

Claim 14. Flitcroft fails to teach, however, Demoff in the same field of endeavor teaches the billing service ... pre-obtaining said first billing data; and

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the billing service providing said first billing data in real time from the billing service providing said first billing data to either the user or the first web site in real-time during a first transaction with the first web-site.

(see col. 12 L 38-53, col. 10 L 25-55, “electronically downloaded to the user’s personal computer”).

Claim 20: Flitcroft explicitly discloses
..organizing said received notification of usage of first and second billing data based at least in part on whether the charges are with the first or the second web sites respectively.

(see col. 24 L 42-62)

Claim 25. the first web site is a selected one of a content provider, a service provider and an access provider (refer to Fig. 1 and col. 9 L 40+ and claim 13).

Claim 43. analyzed per method claim 1.

Claim 44. analyzed per method claim 2.

Claim 45. analyzed per method claim 3.

Claim 48. analyzed per method claim 8.

Claim 49. wherein the apparatus is embedded within a host selected from a set of hosts consisting of: a computing device, an electronic card, a telephone, a personal digital assistant (PDA), a portable audio device, a portable audiovisual device, a cellular telephone, a key-chain dongle, and a transportation device.

(col. 10 L 25-55)

Claims 51 and 52. analyzed per claim 1 and 3 combined.

6. Claims 22-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Flitcroft as applied to claim 20 above.

Claims 22-23: Flitcroft fails to disclose limitation of the billing service disputing.. all notifications of usage of said first and second billing data not associated with the first and second web sites. Official is notice is taken that providing for disputing credit card charges from a

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merchant web site is old and well known business practice. It would have been obvious to one of ordinary skill in the art at the time of the claimed invention to implement these limitations because it would allow the user to have removed any unauthorized charges from his/her account and receive appropriate credit for the unauthorized charges.

Claim 24. Flitcroft fails to disclose limitation of a single press of the control to issue instruction of the user.

Official is notice is taken that providing for a single press of the control to issue instruction to carry out commercial transaction is and well known business practice.

It would have been obvious to one of ordinary skill in the art at the time of the claimed invention to implement a single press of the control to issue instruction which would eliminate need for the user to enter a plurality of instruction parameters related to the disputed charges.

Allowable Subject matter

7. 50 is objected as being allowable if written in independent form.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

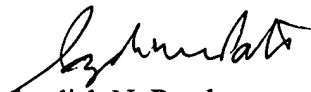
Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAGDISH PATEL whose telephone number is (571) 272-6748.

The examiner can normally be reached on 800AM-600PM M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (571) 272-6747. The fax phone number for the organization where this application or proceeding is assigned is 517-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Jagdish N. Patel

(Primary Examiner, AU 3624)

3/2/06